

REMARKS

In the Office Action mailed June 4, 2009, claims 33, 39, and 40 stand rejected under 35 U.S.C. § 102(c) as being anticipated by Radisch, Jr. et al., U.S. Patent Pub. 2005/0149102 A1 (“Radisch”). Independent claim 33 has been amended to incorporate the elements of dependent claim 35, now canceled. Claim 33 now has the same scope as previously presented claim 35. Dependent claim 35, among other claims, was rejected under 35 U.S.C. § 103(a) as being unpatentable over Radish in view of Sperk, Jr. et al., U.S. Patent No. 5,258,445 (“Sperk”). Radisch, however, is not available to preclude patentability under 35 U.S.C. § 103 because the subject matter of Radisch and the subject matter of the instant application were, at the time the claimed invention was made, owned by or subject to an obligation of assignment to the same entity, namely Scimed Life Systems, Inc., which later became Boston Scientific Scimed, Inc. Accordingly, the rejection of claims 33, 34, and 36-40 must be withdrawn. Applicant believes that claims 33, 34, and 36-40 are in condition for allowance.

New claims 52-57 have also been added. New independent claim 52 has the same scope as previously presented claim 37. Claims 53-57 depend from new independent claim 52. Claim 37 was also improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over Radish in view of Sperk. Accordingly, claims 52-57 are also in condition for allowance.

Claims 19-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,589,286 (“Litner”). This rejection continues to be in error for the reasons presented in the reply filed March 6, 2009. The instant Office Action does not adequately address the previously noted deficiencies.

Contrary to the Examiner’s assertion, Litner does not “discloses a tubular structure (10) comprising at least two fibers, the first fiber being a ceramic fiber and a second fiber made of metal, wherein the ceramic fiber is intertwined with the non-ceramic fiber.” Column 5, lines 18-26 of Litner, instead, recites as follows:

The tubular body and flanges of the present invention may comprise any structural material that is biocompatible and provides the necessary physical properties described herein. For example, the composition of the stent may comprise polymeric materials (both natural and synthetic), ceramic materials,

composite materials, metals, metal oxides, and combinations of such materials. Biodegradable materials are preferred. One preferred structure comprises a network of biodegradable polymeric fibers having a caliber or average diameter of about 0.3 to 0.4 mm. The network may comprises [sic] a non-woven network, woven network, knitted network or the like. Poly-l-lactic acid is a particularly suitable material for stent construction, lasting up to 2 years or more in vitro before total degradation.

Litner, col. 5, lines 15-28.

Although Litner does disclose that the stent can include “polymeric materials (both natural and synthetic), ceramic materials, composite materials, metals, metal oxides, and combinations of such materials,” Litner does not specifically disclose the combination of a ceramic fiber “intertwined” with a metal fiber, as asserted by the Examiner. On the contrary, the only fibers that Litner discloses are biodegradable polymeric fibers. There also is not any discussion in Litner of fibers of different materials intertwined. Accordingly, the rejection is in error and must be withdrawn.

The Office Action has not presented a single reason why one having ordinary skill in the art would elect to make the combination of a ceramic fiber “intertwined” with a metal fiber based on the disclosure of Litner or any other knowledge that one having ordinary skill in the art would have. Instead, the obviousness rejection is premised on a conclusory statement that “it would have been an obvious matter of design choice to modify the Litner reference to obtain the invention as specified in claim 1.” “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Accordingly, without actually providing a non-hindsight based reason for why one having ordinary skill in the art would elect to make a ceramic fiber “intertwined” with a metal fiber based on the disclosure of Litner or any other knowledge within the art, the rejection cannot be maintained.

The Office Action also has not provided any legally sufficient reason for why one having ordinary skill in the art would select “stainless steel, a nickel-titanium alloy, or a combination

thereof" as that metal. The first asserted reason for why it would have been obvious is "because the Applicant has not disclosed that by having a stainless steel or Nitinol provides an advantage, is used for a particular purpose, or solves a stated problem." This is not a legally sufficient reason for supporting a conclusion of obviousness; it is again another conclusory statement that cannot be used to support a conclusion of obviousness. Furthermore, the Examiner's statement confuses the burden placed on the Applicant once the Examiner presents a *prima facie* case of obviousness with the standard placed on the Examiner for making a *prima facie* case of obviousness. *See MPEP § 706.02(j)*. Here, the Examiner has failed to present a *prima facie* case of obviousness because the Examiner has failed to allege a reason for why one having ordinary skill in the art would make the asserted selection of "stainless steel, a nickel-titanium alloy, or a combination thereof."

The second and newly asserted reason for why one having ordinary skill in the art would use stainless steel and/or Nitinol is because one of ordinary skill in the art "would have expected Applicant's invention to perform equally well with the biocompatible metal of the Litner reference because it would perform equally as well." This sentence is confusing and improper. One having ordinary skill in the art at the time of invention would not have knowledge of the instantly claimed invention and thus would not consider whether the "Applicant's invention [performs] equally well with the biocompatible metal of the Litner reference." This demonstrates that the Office Action is improperly asserting that one having ordinary skill in the art would know about the claimed invention and compare it to Litner to determine what changes should be made to Litner. There is no legal support for this type of rejection. Accordingly, the rejection must be withdrawn.

The Office Action also fails to specifically and independently address the dependent claims that depend from independent claim 19. In particular, Litner does not disclose the feature of dependent claims 23 and 24. Although Litner discloses that the fibers can be "a non-woven network, woven network, knitted network or the like," Litner never discloses a "ceramic fiber" knitted or woven with a "non-ceramic fiber." Applicant requests that the Examiner specifically address and explain each rejection of each dependent claim.

Accordingly, each of the pending claims 19-25, 33, 34, 36-40, and 52-57 defines patentable subject matter over the cited prior art. Furthermore, each of the pending claims is believed to be in form for allowance. As such, Applicant requests that the Examiner allow all pending claims 19-25, 33, 34, 36-40, and 52-57. Although Applicant has amended certain claims to advance prosecution, Applicant believes that, before amendment, the claims contained patentable subject matter. As such, Applicant reserves the right to pursue claims of the same or similar scope in a continuation application.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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